



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,072	07/24/2001	James W. Moyer	5051-445	3267

20792 7590 09/09/2003

MYERS BIGEL SIBLEY & SAJOVEC  
PO BOX 37428  
RALEIGH, NC 27627

EXAMINER

SHEINBERG, MONIKA B

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/912,072

**Applicant(s)**

MOYER ET AL.

**Examiner**

Monika B Sheinberg

**Art Unit**

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-69 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☒ Other: *Detailed Action*.

---

**DETAILED ACTION**

**Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, 10, 11, 21-25, 27-30, 63, 64 and 69, drawn to **a method of determining a poinsettia plant profile similarity** wherein fragments of *one sequence* of SEQ ID NOs: **12, 15-25, 27, 30, 34-37, 39, 42 and 44**; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.
- II. Claims 1-11, 21-30, 63, 64 and 69, drawn to a method of determining a poinsettia plant profile similarity wherein fragments of *a specific combination of sequences* of SEQ ID NOs: 12, 15-25, 27, 30, 34-37, 39, 42 and 44; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.
- III. Claims 12-15, 17-20, 41-48, 50-52 and 69, drawn to **a method of determining a plant profile similarity** wherein fragments of *one sequence* of SEQ ID NOs: **1-46**; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.
- IV. Claims 12-20, 41-52 and 69, drawn to a method of determining a plant profile similarity wherein fragments of *a specific combination of sequences* of SEQ ID NOs: **1-46**; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.
- V. Claims 31-35, 37-40 and 68, drawn to **a method of generating poinsettia plant profiles** wherein fragments of *one sequence* of SEQ ID NOs: **12, 15-25, 27, 30, 34-37, 39, 42 and 44**; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.
- VI. Claims 31-40 and 68, drawn to a method of generating poinsettia plant profiles wherein fragments of *a specific combination of sequences* of SEQ ID NOs: 12,

15-25, 27, 30, 34-37, 39, 42 and 44; are analyzed by a corresponding specific combination primer set, classified in class 703, subclass 12.

- VII. Claims 53-57, 59-62 and 68, drawn to **a method of generating plant profiles** wherein fragments of *one sequence* of SEQ ID NOs: 1-46; are analyzed by a corresponding specific combination primer set, classified in class 702, subclass 19.
- VIII. Claims 53-62 and 68, drawn to a method of generating plant profiles wherein fragments of *a specific combination of sequences* of SEQ ID NOs: 1-46; are analyzed by a corresponding specific combination primer set, classified in class 702, subclass 19.
- IX. Claim 65, drawn to **a method for choosing restriction fragments**, classified in class 435, subclass 6.
- X. Claims 66 and 67, drawn to **a method for choosing primers**, classified in class 435, subclass 91.2.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups (I-IV); Groups (VI-VIII); Group IX and Group X are distinct inventions because they have different modes of operation, different functions, or different effects in which each require specific criterion functions to be carried out. Groups (I-IV) are methods concentrated upon the action of determining similarity based upon mathematical comparison methods; Groups (VI-VIII) are methods concentrated upon the action of performing genetic analysis assays for generating data files; Group IX is a method concentrated upon the action of selecting homolog fragments of particular sequences; and Group X is a method concentrated upon the action of selecting primers for amplifying polymorphisms.

The inventions of Groups (I, II) and (III, IV) are distinct inventions because the available sequences of SEQ ID NOs: 12, 15-25, 27, 30, 34-37, 39, 42 and 44 of Groups (I, II) are specific

Art Unit: 1634

for poinsettia cultivars; whereas SEQ ID NOs: 1-11, 13, 14, 26, 28, 29, 31-33, 38, 40, 41, 43, 45 and 46 that are non-specific of Groups (III, IV). A sequence election such as SEQ ID NO: 1 for Group III would not be capable of, as per the claims, to provide a similarity determination of a poinsettia profile as required by Group I. The same is true if a specific combination of sequences such as SEQ ID NO: 13, 14 and 26 were elected for Group IV.

Applicants must specify the specific combination of sequences that are to be utilized for performed assays. Each combination results in a different effect thus a distinct outcome. The sequences and combinations for any plant are different than those specific for poinsettia plants. However, if a sequence or combination that encompasses the poinsettia specific sequences, the groups will be rejoined: as for example, if Group III is elected with SEQ ID NO: 12, Group I will be rejoined as directed to SEQ ID NO: 12; or if Group IV is elected with a specific combination of SEQ ID NOs: 1, 12 and 27-30, Group II will be rejoined as directed to SEQ ID NOs: 12, 27 and 30. The same applies for the restriction of Groups (V-VIII).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

### **Conclusion**

A telephone call was made to Karen Magri on 08 September 2003 with respect to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1634

*Inquiries*

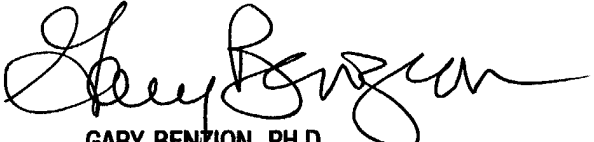
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 9 A.M to 5 P.M. If attempts to reach the examiner by telephone are unsuccessful, the primary examiner in charge of the prosecution of this case, Jehanne Souaya, can be reached at 703-308-6565. If attempts to reach the examiners are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Chantae Dessau, whose telephone number is (703) 605-1237, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

September 8, 2003  
Monika B. Sheinberg  
Art Unit 1634

*MB*

  
GARY BENZION, PH.D  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600